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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/591,147 | 06/09/2000 | Carol Ann Trufant | | 3823 |

7590

09/09/2005

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EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,147

Applicant(s)

TRUFANT, CAROL ANN

Examiner

Dmitry Suhol

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

This application contains claims 2-8 drawn to an invention nonelected with traverse in paper dated 10/25/2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claims 9-20 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). The preamble of claim 9 characterizes the invention as a "method of performing conflict resolution ...", thus the invention is essentially a species of what people and nations have done since time immemorial – communicate to avoid fighting. Stated differently the invention takes old and conventional group discussion to solve conflict and performs that old process in a specific place and by breaking the participants up into smaller groups.

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it

has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed method steps are nothing more than movement between participants and items of conversation (both deemed abstract in nature) in which case the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that conflict resolution will be predictably enabled by the steps set forth as they are drawn to abstract ideas in the first place. Furthermore, there is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an objective standard, for example, step d of claim 9 allows conflict interaction between group participants however there is nothing to say that such interaction will take place. Actual performance of conflict resolution, much less actual resolution of conflict, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a "tangible" result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d

1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). Except for the use of an evaluation form (a peripheral element to the actual process) the remaining steps of the claim are effectively no more than items of conversation and movement between participants that are deemed abstract in nature. Mindful of the need to focus on what the inventor did in fact invent, it is not an evaluation form. The method does not produce a physical transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Even if it might be determined that the claimed method can be characterized as producing a useful, concrete, tangible result, to be proper subject matter for patent eligibility, any useful, concrete, tangible result must be within the useful or technological arts. See e.g., In re Musgrave, 167 USPQ 280 (CCPA 1970); In re Foster, 169 USPQ 99 (CCPA 1971). The Constitution empowers Congress to promote the useful arts. The term “useful arts” has been equated with “technological arts” in a number of decisions. See e.g., In re Waldbaum, 173 USPQ 430 (CCPA 1972).

In this case, the claimed invention is not within the useful or technological arts. Rather, the invention is within the realm of the liberal arts or social sciences. In Musgrave and Foster, the inventions were deemed to be within the technological arts. In those cases, each invention clearly involved computer or machine technology. But here, there is no technology involved at all. There is no technology disclosed or claimed. The evaluation form is a peripheral element to the actual process and cannot reasonably convert an otherwise non-statutory process outside the technological arts into one that is in fact within the technological arts.

Claims 9-20 do not produce a useful, concrete, tangible result in the technological arts. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 9-16 do not define statutory subject matter.

Response to Arguments

Applicant's arguments filed 7/18/2005 have been fully considered but they are not persuasive. Applicants appear to argue that the rejection under 35 USC 101 is improper since a variety of business methods have issued into patents in the past and since the utility of an invention should be judged by whether the result could bring a practical benefit to society rather than a requirement of 100% success. In response the examiner points out that it has been held that "an idea of itself is not patentable, but a new device by which it may be made practically useful is." *Rubber-Tin Pencil Co. v. Howard*, 87 U.S. 498, 507 (1874). Abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work, but a "practical application" of the concept to produce a "useful" result is patentable. The "abstract idea" exception refers to disembodied plans, schemes, or theoretical methods. An "abstract idea" is utilized in an invention that is a "process, machine, manufacture, or composition of matter under 35 USC 101, and is "useful" when it has utility. Where the claim covers any and every possible way that the steps may be performed, this is more likely to be a claim to the "abstract idea" itself, rather than a practical application of the idea. For example, in discussing the mathematical algorithm in *Gottschalk v. Benson*, the

Art Unit: 3725

Supreme Court discussed that cases holding that a principle, in the abstract, cannot be patented and then stated:

Here the "process" claim is so abstract and sweeping as to cover both known and unknown uses of the BCD to pure binary conversion. The end use may...be performed through any existing machinery or future-devised machinery or without any apparatus.

409 U.S. at 68, 175 USPQ at 675. The fact that a claimed method is not tied to a machine, even if the method could be performed by a machine, and that it does not recite a transformation of physical subject matter to a different state or thing, is an indication that the method is a disembodied "abstract idea" and is not a practical application, as broadly claimed.

In this case the claims describe a method of performing conflict resolution. The method as claimed is considered an "abstract idea" because no concrete and tangible means for accomplishing the method is claimed. The method, as claimed, covers any and every possible way of implementing the method, which indicates that it is directed to the "abstract idea" or concept itself, rather than a practical application of the idea. For example, the participants may be assigned and grouped in chat rooms on the internet, in a physical building or even through phone lines with the remainder of the method steps being nothing more than elements of speech. Therefore the claims are directed to nonstatutory subject matter under the "abstract idea" exception.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

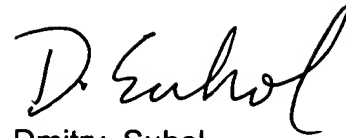
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/591,147
Art Unit: 3725

Page 8

A handwritten signature in black ink, appearing to read "D. Suhol". The signature is fluid and cursive, with a large, sweeping "D" and a long, trailing "Suhol".

Dmitry Suhol
Examiner
Art Unit 3725

ds